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09/535,550	03/27/2000	Jorge A. Morando	MJV-120-A	3595

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EXAMINER

IP, SIKYIN

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BEFORE THE BOARD OF PATENT APPEALS
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MAILED

Paper No. 17

Serial Number: 09/535,550

Filing Date: 03/27/2000

Appellant(s): Morando

SEP - 5 2003

GROUP 1700

Scott A. Mccollister
For Appellant

EXAMINER'S ANSWER

This is in response to the brief on appeal filed June 06,
2003.

(1) Real Party in Interest

A statement identifying the real party in interest is
contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the
related appeals and interferences which will directly affect or
be directly affected by or have a bearing on the decision in the
pending appeal is contained in the brief. Therefore, it is
presumed that there are none. The Board, however, may exercise
its discretion to require an explicit statement as to the
existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2-29 and 34.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on July 30, 2002 has not been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. Claims rejected under 35 U.S.C. § 103 have been trimmed back, the changes are as follows:

Claims 2, 4-27, 29, and 34 are unpatentable under 35 U.S.C. § 103 over JP 09049051.

Claims 2, 4-7, 10-16, 18, 20-26, 29, and 34 are unpatentable under 35 U.S.C. § 103 over JP 08325673.

Claims 2-4, 6-13, 16-26, 29, and 34 are unpatentable under 35 U.S.C. § 103 over JP 63274740.

Claims 2-9, 14-18, 20, 22, 23, 26, 29, and 34 are unpatentable under 35 U.S.C. § 103 over JP 11293410.

(7) Grouping of Claims

The appellant's statement in the brief that all claims do not stand or fall together is not agreed with because all claims have same scope. As is set forth in MPEP § 1206, 37 C.F.R. § 1.192 (c) (7), that "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable."

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Number	Name	Date
11293410	SHIMIZU (Japan Patent Document)	10-1999
09049051	GOTO (Japan Patent Document)	02-1997
08325673	NISHIMURA (Japan Patent Document)	12-1996
63274740	FUJIKI (Japan Patent Document)	11-1988

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 28 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 63274740, JP 09049051, JP 11293410, or JP 08325673 (see their abstracts).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4-27, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 09049051.

Claims 2, 4-7, 10-16, 18, 20-26, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 08325673.

Claims 2-4, 6-13, 16-26, 29, and 34 are rejected under 35

U.S.C. § 103 as being unpatentable over JP 63274740.

Claims 2-9, 14-18, 20, 22, 23, 26, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 11293410.

The cited reference(s) disclose(s) the features including the claimed component of equipment and its compositions. The features relied upon described above can be found in the reference(s) at: their abstracts. The difference between the reference(s) and the claims are as follows: The cited references do not disclose the recited intended use. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie*, and *Mahlman*, 88 USPQ 478 (CCPA 1951). Moreover, an intended use clause found in the preamble of an apparatus/product claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breath from the preamble. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

With respect to the claim 29 that the component such as pumping member, post, or shaft reads on products of cited references because no structure is being recited.

The limitation in claim 34 is material property which would have been inherently possessed by the materials of cited references.

(11) Response to Argument

Appellant's arguments filed June 06, 2003 have been fully considered but they are not persuasive.

Appellant argues that the cited references do not disclose the claimed intended use of the component. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie*, and *Mahlman*, 88 USPQ 478 (CCPA 1951). Moreover, an intended use clause found in the preamble of an apparatus/product claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breath from the preamble. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

Appellant's argument as set forth in page 6, lines 6-10 is noted. But, appellant has not shown the claimed alloying elements and their proportions are critical. Appellant also fails to show the alloys of cited references would not inherently

possess the recited properties. The claimed composition is well overlapped by alloys of cited references. For examples:

Alloying Elements	Apealed claim 26	JP 63274740	JP 8325673	JP 11293410	JP 09049051
B	0.01-2.0	0.5-2.5	0.05-0.5	≤3.0	.005-0.5
C	0.01-2.0	0.1-1.2	1-2.5	≤0.1	1-3
S	0-0.005	---	≤0.03	≤0.04	---
P	0-0.005	≤0.05	≤0.05	≤0.04	---
Cr	5.0-15.0	2-12	4-8	6-28	2-10
Si	0-2.0	0.-0.9	---	2-9	0.1-2.5
Mo	2.0-12.0	5-25	4-8	0.2-4	0.5-8
W	0.5-10.0	5-25	2-6	≤4	0.5-8
V	0.5-5.0	≤20	3-8	≤4	2-8
Nb	0.5-5.0	≤20	0.1-2	0.03-2	0.2-5
Co	0.5-10.0	≤20	0.5-8	≤3	0-5
Fe bal.	Fe bal.	Fe bal.	Fe bal.	Fe bal.	Fe bal.

Appellant's argument in page 6, item B, bottom paragraph is noted. But, claimed 28 does not recite the claimed component is components of a molten metal pump. Furthermore, the phrase "for use in molten melts" is an intended use. Reciting the contemplated end-use in a product claim directed to an old compound does not impart thereto the novelty requisite to patentability, even though the end-use is unobvious. In re Thuau 135 F2d 344, 57 USPQ 324 (CCPA 1943), Ex parte Douros 163 USPQ

667 (POBA), and *In re Craige*, 188 F2d 505, 89 USPQ 393 (CCPA 1951).

Appellant argues that JP 63274740 fails to disclose B as set forth in claim 4 (0.15-0.5 wt.%), and P as set forth in claim 7 (less than about 0.005 wt.%). But, the abstract of said reference discloses 0.5-2.5 wt.% B. The claimed 0.5 wt.% B is anticipated by cited reference. The abstract of said reference discloses P less or equal to 0.05 wt.% P which overlaps the claimed less than 0.005 wt.% P. The claimed contents of both elements are taught, disclosed, and suggested by said reference.

Appellant argues that JP 08325673 fails to teach the S in claim 28, P in claim 28, less than about 1 wt.% Si in claim 10, 1.5-3 wt.% V in claim 16, 2-4 wt.% Nb in claim 18, and less than about 1.5 wt.% Ta in claim 22. But, said reference in abstract discloses 3-8 wt.% V and 0.1-2 wt.% Nb which are anticipated the claimed 3 wt.% V and 2 wt.% Nb in said claims. As stated in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a claimed range is an anticipation of that range."

Appellant's argument as set forth in paragraph bridging pages 7 and 8 of the instant brief is noted. But, appellant fails to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to

the claimed product. See *In re Spade*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), MPEP § 2112.01, and *In re Best*, 195 USPQ, 430

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)."

Appellant's argument as set forth in page 8, first full paragraph is noted. But, said elements' contents read on zero which suggests that said elements are optional elements or could be eliminated from the claimed alloy.

Appellant argues that JP 11293410 fails to teach the less than about 0.005 wt.% S in claim 6, less than about 0.005 wt.% P in claim 7, 2-4 wt.% Nb in claim 18, 3-5 wt.% Co in claim 20, and less than about 1.5 wt.% Ta in claim 22. The S, P, and Ta contents in claims 6, 7, and 22 respectively read on zero which suggests said elements could be eliminated from claims. JP 11293410 in abstract discloses 0.03-2 wt.% Nb and less or equal 3 wt.% Co which are anticipated the claimed 2 wt.% Nb and 3 wt.%

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Co.


Appellant's argument in page 8, bottom paragraph of instant brief is noted. But, said S, P, and Ta elements' contents include zero which suggests said elements are optional elements or could be eliminated from claims. The Cr content (10 wt.%) in appealed claim 9 is anticipated by JP 09049051.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

S. Ip
September 3, 2003

Conferees
Roy V. King, SPE
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